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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/461,402	06/05/1995	ANDREW H. CRAGG	END-140	6448
<div>7590 PAUL F PRESTIA RATNER AND PRESTIA 500 N GULPH ROAD P O BOX 980 VALLEY FORGE, PA 19482</div>				
EXAMINER				
NGUYEN, ANH TUAN TUONG				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
07/06/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

08/461,402

**Applicant(s)**

CRAGG ET AL.

**Examiner**

ANH TUAN T. NGUYEN

**Art Unit**

3731

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2008 and 13 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 89 and 91-95 is/are pending in the application.
- 4a) Of the above claim(s) 91-95 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 89 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. Interference No. 104,083 has been terminated by a decision as favorable to applicant for the count related to Claim 89. A decision by the BPAI was rendered March 10, 1999. *Ex parte* prosecution is resumed.
2. Interference No. 104,192 has been terminated by a decision adverse to applicant for counts related to Claims 55, 59, 62-65, 88, and 90. The interference was terminated on the date of receipt of the CAFC's mandate, which was August 8, 2007 in accordance with 37 CFR 1.197(b) (2). *Ex parte* prosecution is resumed.
3. Status of claims prior to the declarations of interference on April 23, 1998:
  - Claims 2-53 were canceled on June 5, 1995
  - Claims 1, 54, 57, 58, 60, and 61 were canceled on June 24, 1996
  - Claims 56 and 66-87 were canceled on May 27, 1997
4. Claims 55, 59, 62-65, 88 and 90, as to which a judgment adverse to the applicant has been rendered, and stand finally disposed in accordance with 37 CFR 41.127(a)(2).
5. The amendment after termination of interference proceedings filed on October 20, 2008 canceled Claims 1-88, 90 and added new Claims 91-95.
6. Claims 91-95 are withdrawn. See subsequent discussion regarding claims elected by original presentation.
7. Claim 89 is pending and is allowed.

***Priority***

8. On June 5, 1995, in the "Request for Filing a Patent Application under 37 CFR 1.60," applicant requested the first line of the specification be amended to state:

*This application is a division of application number 08/317,763, filed October 4, 1994, (status pending) which is a Continuation-in-Part of application 08/312,881, filed September 27, 1994, status pending.*

9. Subsequent to the declaration of interference #104,192, on November 9, 1998, applicant filed an amendment to the specification, which was not entered. (See Amendment E, dated November 9, 1998.) This amendment will not be entered because the amendment, as proposed, is not understood in light of the June 5, 1995 amended language.

10. In response to this communication, applicant should amend the first paragraph of the specification to include a complete statement of all benefit claims, consistent with all determinations made during the interference proceedings (#104,192 and #104,083). The benefit claim should also include a statement of the status of the related applications/patents.

***Inventorship***

11. Receipt is acknowledged of the March 10, 1999 order in Interference 104,083 that Goicoechea, Hudson, Mialhe be deleted as named inventors. The inventorship has been corrected as requested.

***Election/Restrictions***

12. Election to one of the following species was required under 35 U.S.C. 121 on September 11, 1996:

- Species I, drawn to securing means being a suture.
  - Species II, drawn to securing means being a ring.
  - Species III, drawn to securing means being a staple.
  - Species IV, drawn to securing means being a bead of thermoplastic material.
13. Restriction to one of the following inventions was required under 35 U.S.C. 121 on January 21, 1997:
- Group I, claims 55, 59, 62-65, drawn to a bifurcated stent and method of use.
  - Group II, claims, 56, 66-87, drawn to a wire stent.
14. Applicant's election of species and restriction were made without traverse of Group I, telephonically, on January 09, 1997.
15. Newly submitted claims 91-95 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are drawn to a securing means being a wire formed into a tubular configuration.
16. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 91-95 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Information Disclosure Statement***

17. The two separate interference proceedings involving this application were both declared on April 23, 1998. The application became the subject of a contested case at that time (see 37 CFR 41.100). The rules for interferences further require that before a contested case can be

initiated, the involved application's examination "must be completed" (37 CFR 41.102(a)).

Therefore beginning on April 23, 1998 until termination of proceedings on August 8, 2007, the prosecution in this application was completed and the Board of Patent Appeals and Interferences (and subsequent courts) had jurisdiction, with all other examination proceedings and examination rules being suspended (see 37 CFR 41.103).

18. The information disclosure statements filed March 16, 1999, April 30, 2001, and August 20, 2004 fail to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because they were filed after the application became a contested case in interference proceedings. These rules did not apply at the time these information disclosure statements were filed.

19. The information disclosure statements filed October 20, 2008 and May 13, 2009 fail to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because they were not filed before "an action that otherwise closes prosecution" (i.e., the declaration of interference).

Applicant's submission on these dates must comply with 37 CFR 1.97(d), not 37 CFR 1.97(c).

20. They have been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

*Ex Parte Quayle*

21. This application is in condition for allowance except for the following formal matters:

Claims 91-95 should be canceled.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

22. Any inquiry concerning this communication should be directed to ANHTUAN T. NGUYEN at telephone number (571)272-4963.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anhtuan T. Nguyen  
SPE  
Art Unit 3731

/Anhtuan T. Nguyen/  
Supervisory Patent Examiner, Art Unit 3731  
7/2/09